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MEMPHIS, TN 38132				
EXAMINER				
WOODALL, NICHOLAS W				
ART UNIT		PAPER NUMBER		
3775				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,358

Applicant(s)

SCHWAB ET AL.

Examiner

Nicholas Woodall

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-19, 22-27, 29-40, 49-51 and 53-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1, 3-19, 22-27, 29, 30, 32-40 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 31 and 53-56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-944)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on July 24th, 2009.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 12-19, 29, 30, 32-40, and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Dillhoff (U.S. Patent 4,747,588).

Dillhoff discloses a device comprising a proximal portion and a distal portion. The proximal portion includes a frame having a stationary arm having a handle oriented transversely to the guide members and a moveable arm coupled to the stationary arm, wherein the arms define a C-shaped opening between the arms. The distal portion includes a first guide member extending distally from the movable arm and a second guide member extending distally from the stationary arm, wherein a proximal end of the guide members is attached to the respective arms and the arms are transversely oriented to the guide members. The first and second guide members each include a guide surface extending between a first side and a second side extending between the proximal end and a distal end of the guide members and having a width greater than the width of an element, such as an implant, positioned between the guide members (see Figure 8), wherein the guide surfaces are oriented toward and parallel with the guide surface of the opposite guide member and extend from the proximal end to the distal

end of the guide members. The guide members further include guide flanges extending along only one side of the guide members projecting from the guide surface of one of the guide members towards the guide surface of the other guide member, wherein the guide flanges are on opposing sides along the length of the guide members (see Figure 7 and 8 of the reference). The first and second guide members are moved relative to one another by moving the moveable arm relative to the stationary arm such that the guide surfaces remain parallel. The stationary arm includes a first vertical extension portion coupled to the first guide member, a lateral extension portion extending transversely from the first vertical extension portion, and a second extension portion opposite the first vertical extension, wherein the moveable arm is coupled to the second extension portion. The moveable arm includes a lateral extension portion extending transversely to the second vertical extension portion of the stationary arm and a vertical extension portion opposite the second vertical extension portion and aligned with the first vertical extension portion.

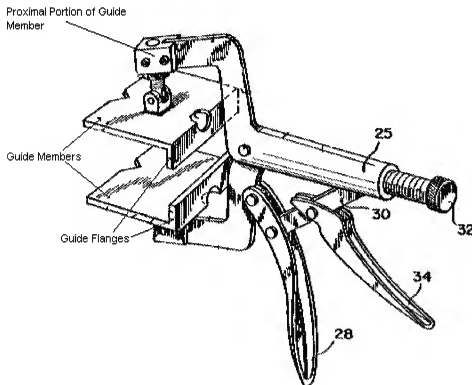
4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dillhoff (U.S. Patent 4,747,588) as second interpretation different from the one discussed above.

Dillhoff discloses a device comprising a proximal portion and a distal portion (see Figure 2 below). The proximal portion includes a frame and the distal portion includes a first guide member and a second guide member. The first guide member and the second guide member each include a first side and a second side extending from a proximal end to a distal end of the guide members, a guide surface extending from the proximal end to the distal end of the guide members between the first and second sides,

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and a guide flange extending along only one side each guide member, wherein the guide flange projects from the guide surface towards the guide surface of the opposite guide member and the guide members being located on opposite sides along a length of the guide members when the guide surfaces are facing one another (see Figures 7 and 8 of the reference).

Figure 2



Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the second interpretation of Dillhoff (U.S. Patent 4,747,588) in view of Zinkel (U.S. Publication 2004/0024291).

Dillhoff discloses the invention as claimed except for the proximal portion of the guide members including a dovetail connection between the guide members the frame. Dillhoff discloses a device wherein the proximal portions of the guide member include a pin and hole connection between the guide members and the frame in order to couple the guide members to the frame (see Figure 3 of the reference). Zinkel teaches a device comprising guide members (94) coupled to a frame (elements 12 and 92), by a dovetail connection, wherein the guide members include a male portion of the dovetail connection and the frame includes a female portion, i.e. receptacle, of the dovetail connection in order to couple the guide members to the frame (see Figure 7A of the Zinkel reference). Because both the device of Dillhoff and the device of Zinkel disclose device comprising a connection between the guide members and a frame, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one connection of the other in order to achieve the predictable results of coupling the guide members to the frame.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over a second interpretation of Dillhoff (U.S. Patent 4,747,588) in view of Zinkel (U.S. Publication 2004/0024291).

Dillhoff discloses a device comprising a proximal portion and a distal portion (see Figure 2 above). The proximal portion includes a frame and the distal portion includes a first guide member and a second guide member. The first guide member and the second guide member each include a first side and a second side extending from a proximal end to a distal end of the guide members, a guide surface extending from the proximal end to the distal end of the guide members between the first and second sides, and a guide flange extending along only one side each guide member, wherein the guide flange projects from the guide surface towards the guide surface of the opposite guide member and the guide members being located on opposite sides along a length of the guide members when the guide surfaces are facing one another (see Figures 7 and 8 of the reference). Dillhoff fails to disclose the proximal portion of the guide members including a dovetail connection between the guide members the frame. Dillhoff discloses a device wherein the proximal portions of the guide member include a pin and hole connection between the guide members and the frame in order to couple the guide members to the frame (see Figure 3 of the reference). Zinkel teaches a device comprising guide members (94) coupled to a frame (elements 12 and 92), by a dovetail connection, wherein the guide members include a male portion of the dovetail connection and the frame includes a female portion, i.e. receptacle, of the dovetail connection in order to couple the guide members to the frame (see Figure 7A of the Zinkel reference). Because both the device of Dillhoff and the device of Zinkel disclose device comprising a connection between the guide members and a frame, it would have been obvious to one having ordinary skill in the art at the time the invention was made

to substitute one connection of the other in order to achieve the predictable results of coupling the guide members to the frame.

8. Claims 1, 3-9, 11-13, 17, 19, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich (U.S. Patent 5,431,658) in view of Dillhoff (U.S. Patent 4,747,588).

Moskovich discloses a device comprising a proximal portion and a distal portion. The proximal portion includes a frame (23) having a stationary arm (one element 24) and a moveable arm (second element 24) coupled to the stationary arm. The distal portion includes a first guide member (1) extending distally from the movable arm and a second guide member (2) extending distally from the stationary arm, wherein a proximal end of the guide members is attached to the respective arms and the arms are transversely oriented to the guide members. The first and second guide members each include a guide surface extending between a first side and a second side extending between the proximal end and a distal end of the guide members and having a width greater than the width of an element, such as an implant, positioned between the guide members, wherein the guide surfaces are oriented toward and parallel with the guide surface of the opposite guide member and extend from the proximal end to the distal end of the guide members. The first and second guide members further include an abutment member adjacent the distal end of the guide members, wherein the abutment member project from the guide members in a direction opposite the guide surface and a support member extending distally from the abutment members, wherein the guide surface can include a number of guide rails that terminate adjacent the abutment

members and wherein the guide surface extends beyond the guide rails along the support members and is planar along the support members (see Figure 3) or wherein the guide surface is planar along the entire length (see Figure 4). Moskovich fails to disclose the device wherein the guide members further include a guide flange. Dillhoff teaches a device comprising guide members (45 and 46) that include a guide flange (49) extending along only one side of the guide members such that guide flanges are on opposite sides of the guide members when the guide surfaces of each guide member are oriented toward each other (see Figures 7 and 8 of the reference) in order to allow the guide members grip and support a wide variety of workpieces (column 3 lines 20-34 and column 4 lines 29-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Moskovich wherein the guide members further include guide flanges in view of Dillhoff in order to grip and support a wide variety of workpieces.

Allowable Subject Matter

9. Claim 11 is allowed.
10. Claims 31 and 53-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed July 24th, 2009 have been fully considered but they are not persuasive. The applicant's argument that the Dillhoff reference does not disclose a device wherein the frame portion is structured to move the guide members

with the surfaces remaining parallel/the arms being adapted to move the guide members with the surfaces remaining parallel/ the arms being moveable with the surfaces remaining parallel is not persuasive. The terms "structured to", "adapted to", and "movable" are all functional terms making the limitation a functional limitation, wherein the disclosed references only need to be capable of providing the function. The guide members are pivotally connected to the arms in the Dillhoff reference and are capable of being moved wherein the guide surfaces remain parallel. The guide members (1 and 2) of the Moskovich reference are capable of sliding along the length of the arms (24) of the frame and keeping the guide surfaces parallel during the movement. Regarding claim 38, the claim requires the frame to be structured to move the guide members wherein the guide surfaces remain generally parallel, which means the surfaces do not have to be parallel. The references clearly also read upon the limitations of claim 38 as discussed above. The applicant's argument that the Dillhoff reference does not disclose the arms connected to the proximal ends of the guide members is not persuasive. The guide members includes a proximal end, i.e. a proximal half of the device, and a distal end, i.e. a distal half of the device, and the arms couple to the guide members in the middle of the guide member and therefore are connected at both the proximal end and the distal end. The claim does not require the arm to be coupled to the terminal distal end of the guide members. The examiner has not provided new grounds of rejection making this office action **FINAL**.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775